



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Koichi OGAKI

Group Art Unit: 3661

Application No.: 10/086,530

Examiner: R. Camby

Filed: March 4, 2002

Docket No.: 112056

For: VEHICLE TRAVELING STATE RECORDING METHOD AND COMPUTER FOR
ENGINE CONTROL

**STATEMENT OF SUBSTANCE OF INTERVIEW AND SUPPLEMENTAL
REMARKS**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A personal interview was held with Examiner Camby on March 15, 2005. Applicant thanks the Examiner for the courtesies extended to Applicant's representative during the personal interview. Moreover, Applicant thanks the Examiner for his agreement during the personal interview that claims 1 and 9 define over U.S. Patent 6,671,614 to Weisman.

During the personal interview, the distinguishing features of claims 1-4, 8-12, 15 and 16 with respect to Weisman were discussed. The points presented included the arguments found in the Amendment filed February 17, 2005.

Specifically, with respect to claims 1 and 9, Applicant's representative asserted that Weisman fails to disclose a vehicle traveling state recording method comprising, recording information on traveling states, stopping the recording of the information on the traveling states when the vehicle stops, reading the recorded information out, and outputting the read-out information, as claimed in claim 1; or a computer controlling and engine comprising,

an input section for inputting information on traveling states, a memory, a controller, the controller stopping the recording of the information when the vehicle stops, and the controller outputting the information, as claimed in claim 9. Applicant's representative reviewed with the Examiner that Weisman discloses that the electronic control module 20 can sample various sensors at regular intervals under controlled conditions, or it can sample continuously (col. 9, lines 39-41; col. 10, line 35-col. 11, line 1). As discussed above, the Examiner agreed that Weisman does not disclose all of the features of claims 1 and 9.

With respect to claims 15 and 16, Applicant's representative asserted that Weisman fails to disclose a vehicle traveling state recording method comprising, recording information on traveling states in a time-series manner in a computer, changing a connection state of a predetermined terminal of the computer, and after the changing, reading the recorded information, as claimed in claim 15; or a computer controlling an engine, the computer comprising, an input section for inputting information on traveling states, a memory for recording the information in a time-series manner, and a controller for controlling the information, the controller outputting the information recorded in the memory when a connection state of a predetermined terminal of the computer is changed, as claimed in claim 16.

With respect to the feature "changing a connection state of a predetermined terminal of the computer; and after the changing, reading the recorded information out," as claimed in claim 15, and similarly claimed in claim 16, the Examiner referred to page 2 of the November 17, 2004 Office Action. The Examiner stated that these features are anticipated by Weisman and alleged that Weisman discloses an engine control module 20 that is a computer with microprocessor 24 and ROM 28 and RAM 26 to record data and output it to user interface 34 at a later time or present time. The Examiner asserted that the "changing a

connection state" features are inherent in this disclosure because one can read out the data at a later time or present time.

Applicant maintains that these features are not disclosed or inherent in the applied prior art. First, Weisman does not disclose the language "at a later time or present time." Moreover, even if Weisman did disclose the "at a later time or present time" language, this language does not establish inherency of the "changing a connection state" features.

The Examiner is reminded of the burden of proof to establish inherency. MPEP §2112 states that the Patent Office must provide rationale or evidence tending to show inherency. Citing In re Robertson, 169 F.3d 743, 745, 49 USPQd 1949, 150-51 (Fed. Cir. 1990), MPEP §2112 states, "[i]nherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Additionally, citing Ex Parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990), §2112 states, "[i]n relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art" (emphasis in original). In other words, if there is even a possibility that a feature is not present, then the Patent Office may not rely on a theory of inherency.

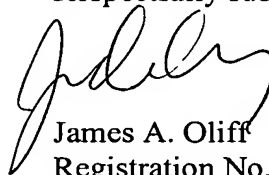
During the personal interview, the Examiner failed to put forth any rationale or evidence tending to show inherency or a basis in fact and/or technical reasoning to support that the "changing a connection state" features of claims 15 and 16 are inherent in the applied art. Moreover, Applicant's representative put forth during the personal interview that Weisman may record data and output data without changing a connection state at either a later time or a present time. Thus, because a possibility exists that Weisman does not require the "changing a connection state" features, as claimed in claims 15 or 16, this feature clearly

is not inherent in Weisman. Accordingly, the withdrawal of the rejection under 35 U.S.C. §102(e) is respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: March 25, 2005

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